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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/337,737	06/22/1999	YOJI ISHIDA	21.1927/NLO	9339

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EXAMINER	
NGUYEN, NGA B	
ART UNIT	**PAPER NUMBER**
3628	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/337,737	ISHIDA ET AL.	
	Examiner	Art Unit	
	Nga B. Nguyen	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23 and 36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23 and 36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is the answer to the communication filed on February 28, 2005, which paper has been placed of record in the file.

2. Claims 1-23 and 36 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-23 and 36 have been considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-23 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van De Pavert, U.S. Patent No. 5,914,471, in view of Boyer et al. (hereinafter Boyer), U.S. Patent No. 6,208,973, and further in view of Yanagihara et al. (hereinafter Yanagihara), U.S. Patent No. 6,370,517.

Regarding to claims 1, 10, and 17, Van De Pavert discloses a system, a method, and a computer readable medium encoded with a program for transaction settlement

with an electronic cashing card having a non-authentication processing memory and an authentication processing memory, said system comprising:

means for updating an authentication balance stored in a balance area of the authentication processing memory and a non-authentication balance stored in a balance area of the non-authentication processing memory, said means updating the authentication balance to a balance amount after settlement when a transaction is settled by an authentication process having a requirement for a personal authentication to be matched, said means updating the non authentication balance to an amount less than or equal to the stored authentication balance when the transaction is settled by the authentication process (Col. 2, lines 57-62 and col.8, line 49-col. 9, line 27, Col. 4, line 58-col. 5, line 8).

Van De Pavert does not explicitly disclose that the two balances are on a card. However, Boyer discloses such step (Col. 7, lines 1-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such step. One would have been motivated to include such step in order to facilitate the use of the system.

Moreover, Van De Paved does not explicitly disclose means for comparing the non-authentication balance and the authentication balance and determining that an illegal process has been performed with the card when the non-authentication balance is larger than the authentication balance. However, Yanagihara discloses such step (Col. 5, lines 10-60). Therefore, it would have been obvious to one having ordinary skill

in the art at the time the invention was made to include such step. One would have been motivated to include such step in order to increase the security of the system.

Regarding to claims 2, 11 and 18, Van De Pavert, Boyer and Yanagihara disclose a system, a method and a computer readable medium encoded with a program as recited in claims 1, 10 and 17. Van De Pavert also discloses: when a transaction is settled by a non-authentication process wherein the personal authentication is not required to be matched, the balance amount after settlement is calculated based on the stored authentication balance and the non-authentication balance is updated to the balance amount after settlement (Col. 3, lines 6-44)-, and when a transaction is settled by the authentication process, the balance amount after settlement is calculated based on the stored non-authentication balance and both the authentication balance and the non-authentication balance are updated to the balance amount after settlement (Col. 7, line 39-45).

Regarding to claims 3, 12 and 19, Van De Paved, Boyer and Yanagihara disclose a system, a method and a computer readable medium encoded with a program as recited in claims 1, 10 and 17. Van De Pavert also discloses: when the transaction is settled by a non-authentication process wherein the personal authentication is not required to be matched, the balance amount after settlement is calculated based on the stored non-authentication balance and the non-authentication balance is updated to the balance amount after settlement (Col. 7, lines 51-60), and when a transaction is settled by the authentication process, the balance amount after settlement is calculated based on the stored authentication balance and the stored non authentication balance, the

authentication balance is updated to the balance amount after settlement, and the non-authentication balance is updated according to a preset condition amount (Col. 9, line 43-col. 10, line 12).

Regarding to claims 4, 13 and 20, Van De Pavert, Boyer and Yanagihara disclose a system, a method and a computer readable medium encoded with a program as recited in claims 1, 10 and 17. Van De Pavert also discloses the authentication balance and the non authentication balance are compared in each of successive transactions to be settled by a non authentication process wherein the personal authentication is not required to be matched, when a count of the successive transactions completed is less than or equal to a predetermined number (Col. 10, lines 13-67).

Regarding to claims 5, 14 and 21: Van De Pavert, Boyer and Yanagihara disclose a system, a method and a computer readable medium encoded with a program as recited in claims 1, 10 and 17. Van De Pavert also discloses wherein: a settlement amount limit is set for settlement of transactions by a non-authentication process wherein the personal authentication is not required to be matched (Col. 11, lines 47-61), and said comparing and determining means determines that an illegal process has been performed with the card when a disbursement amount, to be written in the non-authentication processing memory as a disbursement history, exceeds the settlement amount limit (Col. 1 1, line 62-col. 12, line 27).

Regarding to claims 6 and 22, Van De Pavert, Boyer and Yanagihara disclose a system and a computer readable medium encoded with a program as recited in claims

1, and 17. Van De Pavert also discloses wherein when the authentication process is invoked to perform a deposit or to settle a transaction, a money amount is deposited for the authentication process and is written to a predetermined area of the non-authentication processing memory, the money amount comprising at least one of a predetermined cash amount and a predetermined rate amount (Col. 1, lines 1-46).

Regarding to claims 7, 16 and 23, Van De Paved, Boyer and Yanagihara disclose a system, a method and a computer readable medium encoded with a program as recited in claims 1 , 10 and 17. Van De Pavert also discloses comprising within the card: arithmetic means for executing arithmetic calculations for the authentication process and a non-authentication process wherein the personal authentication is not required to be matched, said arithmetic means further controlling data reading and writing operations from and to the non-authentication processing memory and the authentication processing memory (Col, 13, lines 45-62)', and input and output means for executing data input/output operations between the arithmetic means and an external unit (Col. 13, line 62-col. 14, line 22).

Regarding to claim 8, Van De Pavert, Boyer and Yanagihara disclose the system recited in claim 1. Van De Pavert also discloses wherein the card comprises an integrated circuit (smart card uses integrated circuits (Col. 12, lines 28-37).

Regarding to claim 9, Van De Paved, Boyer and Yanagihara disclose the system recited in claim 1. Van De Paved also discloses wherein the card is a prepaid card (Col. 12, lines 28-48).

Regarding to claim 15, Van De Pavert, Boyer and Yanagihara disclose the method recited in claim 10. Van De Paved also discloses wherein when the authentication process is invoked to perform a deposit or to settle a transaction, a money amount is deposited for the authentication process and is written to a predetermined area of the non-authentication processing memory, the money amount comprising at least one of a predetermined cash amount and a predetermined rate amount (Col. 14, lines 23-39).

Regarding to claim 36, Van De Pavert discloses a transaction settlement method, comprising updating a non-authentication balance that is stored on a card to an amount less than or equal to an authentication balance (Col. 2, lines 7-62 and col.8, line 49-col. 9. line 27, Col. 4, line 58-col. 5, line 8).

Van De Pavert does not explicitly disclose that the two balances are on a card. However, Boyer discloses such step (Col. 7, lines 1-10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such step. One would have been motivated to include such step in order to facilitate the use of the system.

Moreover, Van De Pavert does not explicitly disclose determining that an illegal process has been performed with the card when the non-authentication balance is larger than the authentication balance. However, Yanagihara discloses such step (Col. 5, lines 10-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such step. One would have been motivated to include such step in order to increase the security of the system.

Conclusion

6. Claims **1-23 and 36** are rejected.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen, whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough, can be reached on (571) 272-6799.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

8. **Any response to this action should be mail to:**

Commissioner of Patents and Trademarks

c/o Technology Center 3600

Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

or:

(571) 273-0325 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Knox building, 401 Dulany Street, Alexandria, VA, First Floor (Receptionist).

Nga B. Nguyen

Nga Nguyen

May 25, 2005